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DATE: **4 November 2004** COVER SHEET & **3** PAGE(S)ATTORNEY DOCKET NUMBER: **33734-8020US4**RETURN TO: (NAME) **Melody Almberg** (EXT.) **6771** (ROOM NO.) **4183**ORIGINAL DOCUMENT(S) WILL BE: ☐ SENT TO YOU ☒ HELD IN OUR FILES

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IN RE APPLICATION OF: **ANDREW D. FIRLIK ET AL.**APPLICATION NO.: **10/072,700**FILED: **FEBRUARY 7, 2002**FOR: **METHODS AND APPARATUS FOR
EFFECTUATING A CHANGE IN A
NEURAL-FUNCTION OF A PATIENT**EXAMINER: **RODERICK D.
BRADFORD**ART UNIT: **3762**CONF. NO: **2530****Enclosures: Response to Restriction Requirement**

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Date: **4 November 2004**By: **/Edward S. Hotchkiss/****Edward S. Hotchkiss**

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Signed: /Edward S. Hotchkiss/
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: ANDREW D. FIRLIK *ET AL.*

APPLICATION NO.: 10/072,700

FILED: FEBRUARY 7, 2002

FOR: **METHODS AND APPARATUS FOR
EFFECTUATING A CHANGE IN A
NEURAL-FUNCTION OF A PATIENT**EXAMINER: RODERICK D.
BRADFORD

ART UNIT: 3762

CONF. NO: 2530

Response to Restriction Requirement

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The present communication responds to the Office Action dated October 4, 2004, in which the Examiner divided the claims into the following groups:

- Group I, Claims 1-18 and 26-42, drawn to a method of effectuating a neural-function in a patient; and
- Group II, Claims 19-25, drawn to a method effectuating a neural-function in a patient.

In response, the applicants elect Group I without traverse. Although the restriction requirement has not been traversed, the undersigned would like to clarify one matter for the record. In support of the restriction requirement, the Examiner contends that "the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require applying an electrical stimulation directly to the stimulation site." Neither claim 1 nor claim 19, for example, use the term "directly." To the contrary, claim 1 calls for "applying an electrical potential to the stimulation site via the electrode" and claim 19 refers to "applying an electrical potential to the selected stimulation site via an electrode." The

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undersigned expresses no opinion on any difference between the Examiner's characterization of the claims and the language of the claims themselves.

The Examiner has further required an election of species if Group I is selected. In particular, the Examiner requires election between the following patentably distinct species:

Embodiments 1-8, represented by selecting a stimulation site a *[sic, at]* the cortex, selecting a stimulation site adjacent to the cortex, positioning an electrode at the premotor cortex, positioning an electrode at the supplementary motor cortex, positioning an electrode in the patient at the broca's *[sic, broca's]* area of the inferior frontal lobe, positioning an electrode in the patient at Wernick's area of the prefrontal lobe, positioning an electrode in the patient at a medial temporal lobe, and positioning an electrode in the patient at a limbic system component.

(Page 3 of the Office Action.) Before electing a species and identifying which claims read on the species, the undersigned would like to clarify the definitions of the species. First, the Examiner identifies one of the patentably distinct species as an embodiment drawn to selecting a stimulation site at the cortex. Both claims 1 and claim 10 refer to "selecting a stimulation site at the cortex of the patient." Claims 3-9 depend from claim 1 and appear to parallel embodiments 2-8 identified by the Examiner; claims 12-18 depend from claim 10 and likewise parallel the Examiner's listing of embodiments 2-8. Does the Examiner consider the first embodiment a subgenus, with at least some of the additional embodiments being patentably distinct species of the subgenus?

The Examiner also defines one of the embodiments as "selecting a stimulation site adjacent to the cortex." The undersigned assumes that the Examiner is referring, e.g., to claim 3, which specifies that "selecting the stimulation site comprises choosing a stimulation site adjacent to a damaged region of the cortex." Claim 3 depends from claim 1, which refers to selecting a stimulation site at the cortex. To clarify the record, claim 3 (for example) refers to selecting a stimulation site that is adjacent to a damaged region of the cortex, not a stimulation site that is adjacent to the cortex *per se*.

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With that clarification in mind, the undersigned elects to proceed with examination of the third embodiment identified by the Examiner, i.e., the embodiment "represented by... positioning an electrode at the premotor cortex." At least claims 1, 2, 4, 10, 11, 13, and 28 read on this embodiment. Of these, claims 1, 2, 10, and 11 are generic in the sense that each one reads on the elected species and at least one other species defined by the Examiner.

Accordingly, applicants have elected to begin prosecution with examination of at least claims 1, 2, 4, 10, 11, 13, and 28. Upon allowance of any generic claim, applicants request consideration of claims to additional species.

No fees are believed due with this communication. However, the Commissioner is hereby authorized and requested to charge any deficiency in fees to Deposit Account No. 50-0665.

Respectfully submitted,
Perkins Coie LLP

Date: 4 November 2004

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